

PATENT

Application Serial No.: 10/642,978
Attorney Docket No.: 97-558-C1**REMARKS****A. INTRODUCTION**

Claims 1 – 5 are pending and rejected.

Claim 1 is the only independent claim.

Claim 1 is amended by this Amendment without prejudice or disclaimer, solely for business reasons and to recite a desired embodiment.

B. SECTION 101 REJECTION

Claims 1 - 5 have been rejected as non-statutory. Applicants traverse this rejection since there has been no prima facie showing that any claim is non-statutory.

The Examiner contends that claims 1 - 5 are per se non-statutory because they are directed to "a method of producing a disembodied data structure". However, this analysis is essentially reversed.

The test for statutory subject matter is that the claims produce a useful, concrete and tangible result. In other words, the inquiry must focus on whether the claims produce a useful, concrete and tangible result, not on whether the claims produce "a disembodied data structure". Instead, the Examiner has assumed that since the claims produce "a disembodied data structure", they must fail to produce a useful, concrete and tangible result.

Since the Examiner has failed to demonstrate that the claims fail to produce a useful, concrete and tangible result, and since each does in fact produce a useful, concrete and tangible result (as described in the specification), there has been no prima facie showing that the claims are non-statutory.

Further, the Examiner's suggestion (that Applicants amend to recite that *outputting* is performed by a point-of-sale terminal) establishes that the Examiner is in fact still relying on the previously alleged failure to "to fall within the technological arts". Since there is no technological arts requirement, this rejection and the Examiner's insistence that an *outputting* step be performed by a computer are improper. See, e.g., *Ex parte Lundgren*, Appeal No. 2003-2088 (BPAI 2005).

Applicants also do not understand why performing the *outputting* step by a point-of-sale terminal would satisfy the Examiner's standard for statutory subject matter, but *determining a monetary value using a point-of-sale terminal*, as currently recited, does not.

Applicants respectfully note that each of the pending claims is directed to a practical application (i.e. a useful, concrete, and tangible result) at least because

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Claim 1 recites *determining a monetary value*. The Federal Circuit found the claims at issue in State St. Bank were directed to a practical application because a “final share price” was determined that could be relied upon by interested parties. Similarly, in addition to any useful, concrete, and tangible results that are made possible by the *determined monetary value* (e.g., reliance on it by merchants, customers, or lotteries; use in allocating a portion of a ticket), the monetary value determined using the point-of-sale terminal is itself a useful, concrete, and tangible result.

Applicants respectfully submit that all pending claims are directed to a practical application and request reconsideration of the Section 101 rejections.

1. Double Patenting Rejection

Claims 1 - 5 are rejected as unpatentable over claims 1 - 12 of U.S. Patent No. 6,267,670. Applicants traverse this rejection since there has been no prima facie showing that any pending claim is rendered obvious by any or all of claims 1 - 12 of U.S. Patent No. 6,267,670.

The Examiner asserts:

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are drawn to the same essential subject matter.

[Office Action, page 3].

Clearly, this fails to present a prima facie case of obviousness-type double patenting since there is no obviousness analysis of any pending claim.

1.01. The Examiner has obfuscated the grounds for rejection

In our previous response Applicants stated that the Examiner had failed to provide the appropriate obviousness analysis (e.g., by failing to find the level of ordinary skill in the art, by failing to identify what features were missing from the identified patent claims, and by failing to indicate evidence of a motivation to modify the patent claims to provide for missing features).

Confusingly, in response the Examiner now asserts that “no modification is necessary” and that the “instant claims are anticipated by the patent.” [Office Action, page 7 (emphasis added)]. If no modification of a patented claim is necessary, then the Examiner would be making a statutory double patenting rejection based on a finding that the present claims are identical in scope to issued claims. If the Examiner is not stating the claim scope is identical, then the Examiner, in order to establish an obviousness-type double patenting rejection,

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must identify the missing feature(s) and provide evidence of a motivation to provide or remove any missing feature.

The Examiner has obfuscated the grounds for rejection to the point that proper notice has not been provided in accordance with 35 U.S.C. § 132. Applicants are at a loss as to how to proceed in the face of this rejection, as the Examiner has now asserted in the same Office Action (1) that 6,267,670 somehow "anticipates" all of the pending claims and (2) that all of the pending claims are rejected for obviousness-type double patenting over the claims of 6,267,670. The conclusions are mutually exclusive—the presently claimed subject matter is either identical to the issued claims or it is not.

Applicants respectfully request that the Examiner reconsider the double patent rejection and make the requisite findings of record. In particular, the Examiner must decide whether any pending claim is identical in scope to any issued claim and state so clearly. The Examiner must also identify any pending claim that is impermissibly obvious over a particular issued claim, identify any missing features, and provide a motivation to provide or remove any such features.

Applicable Law

Any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. § 103 obviousness determination. MPEP 804(II)(B)(1). Thus, the factual inquiries set forth in Graham v. John Deere that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103 are employed when making an obvious-type double patenting analysis. MPEP 804(II)(B)(1).

The factual inquiries that must be made are:

- (A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of nonobviousness.

See MPEP 804(II)(B)(1).

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When considering whether a claim of an application is an obvious variation of a claim of a patent, the disclosure of the patent may not be used as prior art. MPEP 804(II)(B)(1).

One-way test was not applied

The patent used in the double patenting rejection was not filed after the filing date of the present application. Therefore, the "one-way test" is required. MPEP 804(II)(B)(1)(a).

This test is a determinant of whether the invention defined in a claim in the application is an obvious variation of the invention defined in a claim in the patent. MPEP 804(II)(B)(1)(a).

However, here the Examiner has asserted that only that the pending and issued claims "are drawn to the same essential subject matter". Applicants traverse any implication that any particular feature or combination of features is "essential."

Claim Limitations Ignored

In addition, in determining the obviousness of a claim, all claim limitations must be considered. Each of the pending claims has been rejected in one sentence double patenting rejections. The general rejection ignores several claim limitations of the claims. Like any other obviousness rejection, the Examiner must address each claimed feature, and cannot refer generally to the "essential subject matter."

No motivation to Modify

No motivation to modify the patent is indicated. There is only the conclusory statement that the issued claims are essentially the same subject matter as the pending claims. The motivation must be a specific teaching or suggestion in the prior art to combine or modify the references of record.

2. Section 103(a) Rejections

Claims 1 - 5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over a combination of Nilssen (US 5,083,784) and Burke (US 6,112,191). Applicants traverse this rejection since there has been no prima facie showing that any pending claim is rendered obvious by the references of record, either alone or in combination.

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However, solely for business reasons and in order to expedite allowance of the present rejection, Applicants have amended independent Claim 1 without prejudice or disclaimer to recite a desired embodiment. Applicants intend to pursue the originally-claimed subject matter of the pending claims in one or more continuing applications.

Specifically, Claim 1 now recites an embodiment in which *the allocated portion of the ticket is less than the whole of the ticket*. Neither Nilssen nor Burke, alone or in combination, suggest any such feature.

Applicants respectfully request the withdrawal of the Section 103(a) rejection of Claims 1 – 5.

3. Additional Comments

Applicants respectfully disagree with the Board's finding in Ex parte Walker. First, neither the Board nor the Examiner indicates evidence of record that *a portion of a ticket* would have been interpreted, by one of ordinary skill in the art in accordance with its ordinary meaning, as descriptive of the whole of a ticket. Applicants do not necessarily disagree here with the Board's or Examiner's finding on that point, but note that it seems unlikely that one of only ordinary skill in the art, upon considering Roberts or Nilssen would have found in it the suggestion that the vending or sale of a lottery ticket for its full price should be understood, customarily and ordinarily, as allocating a portion of that ticket.

Second, even accepting the Board's interpretation of "portion of a ticket," Nilssen does not seem to suggest that the allocation or designation of some portion (whole or less than whole) of a ticket could be somehow based on a determined monetary value. If Nilssen discloses only selling a whole ticket at a fixed, predetermined value (as Applicants understand it), it does not suggest in any way that the "wholeness" of the purchased ticket has anything to do with, requires, or is somehow based on, the fixed purchase price. To modify Nilssen to provide for such consideration would add unnecessary complexity to a system that is wholly devoted only to (and has no contemplation of anything other than) full price tickets. Nilssen cannot reasonably suggest the desirability of a feature that has anything to do with how the "wholeness" of that ticket relates to "allocating" or setting apart that whole ticket *based on* a determined monetary value.

Our silence with respect to the Examiner's other various assertions not explicitly addressed in this paper, including assertions of what the cited reference(s) teach or suggest, the alleged motivation to combine the cited references, or the Examiner's interpretation of claimed subject matter, is not to be understood necessarily as agreement.

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Applicants do not believe that any fees are necessary to make this response timely.

Please grant a petition for any extension of time required to make this Response timely.

If necessary, please charge any additional fees that are necessary, using the following information:

Deposit Account: 50-0271

Order No.: 97-558-C1

Please credit any overpayment to the same account.

D. CONCLUSION

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mtdowns@walkerdigital.com.

Respectfully submitted,

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